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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,758	02/24/2004	Katsuhiko Yamashita	Q79843	2197

7590

07/14/2004

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EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/784,758	Applicant(s) YAMASHITA ET AL.	
	Examiner Thorl Chea	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6 and 9-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,6 and 9-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02242004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5-6, 9-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP'0838719A2 (EP'719).

See especially page 53-54 claims 1-8; sensitizing dye contains aromatic group 19-30; page 31 lines 56-page 4 line 1; and page 40 lines 15-20; the use of the cationic cyanine dye and anionic cyanine dye on page 31, lines 36-51, and the use of multiple dyes in Table 2, page 40; Table 8 on page 45. The silver halide of the EP'719 were multiplayer coated spectral sensitizing dyes having structural formula of the compound used in the claimed invention such as the one containing an aromatic ring, and having light absorption strength presented in the claimed invention. See also the use of the silver halide Tabular on page 38, Example 1. EP'719 discloses the emulsion coated with

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multiple layers of dye used in the present invention, and in the absence of showing otherwise, The Examiner asserts the invention as claimed is either anticipated by or found obvious over EP'719. The ratio of $A = 0.9$ or less would be inherent to the silver halide taught in EP'719 since the sensitivity of silver halide grains would be reduced after processing, and G1 value would be less than that of G0.

4. Claims 5-6, 9-22 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamashita et al, US Patent 6,180,332 (US'332). See especially the abstract; columns 74-76 claims 1-12; spectral sensitizing dyes in columns 7-26; column 44, lines 24-52; Table 1 in columns 55-56 wherein the emulsion contains a multiple dyes ; columns 59-60, Table 4; and Table 7 in columns 61-62. The silver halide of the US'332 patent were multiplayer coated spectral sensitizing dyes having structural formula of the compound used in the claimed invention such as the one containing an aromatic ring, and having light absorption strength presented in the claimed invention. Yamashita discloses the emulsion coated with multiple layers of dye used in the present invention, and in the absence of showing otherwise, the Examiner asserts the invention as claimed is either anticipated by or found obvious over Yamashita. The ratio of $A = 0.9$ or less would be inherent to the silver halide taught in Yamashita et al since the sensitivity of silver halide grains would be reduced after processing, and G1 value would be less than that of G0.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 5-6, 9-22 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Parton et al (US Patent No. 6,143,486) Parton discloses silver halide emulsion multicoated with dye containing a cationic substituent and anionic described on page 43 of the present specification. Note also to the LogS Figs 1-3 and the abstract wherein the outer dye layer absorbs light at equal or higher energy than inner dye. Parton discloses an emulsion having thereon a multiple layers of sensitizing dye including the combination of cationic dye and cationic dye within the scope of the dye used in the present claimed invention. Note also the emulsion having multiple layers of dye in columns 31-34, Table II. Parton discloses the emulsion coated with multiple layers of dye used in the present invention, and in the absence of showing otherwise, the Examiner asserts the invention as claimed is either anticipated by or found obvious over Parton. The ratio of $A = 0.9$ or less would be inherent to the silver halide taught in Parton since the sensitivity of silver halide grains would be reduced after processing, and G1 value would be less than that of G0

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 5-6, 9-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-116 of U.S. Patent No. 6,582,894.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims are related to similar silver halide emulsion with same light absorption intensity and same A_{max} and S_{max} .

Response to Arguments

10. Applicant's arguments filed December 5, 2002 have been fully considered but they are not persuasive because of the rejection set forth above and the Examiner's position set forth in the previous office action. The applicant fails to show whether the claimed material is not anticipated or obvious over the applied prior art set forth above. The applied prior art of record discloses a silver halide emulsion having coated with multiple layers of dye having functional group same as taught in the prior art of record. The dye having similar utilities as that used in the present claimed invention, and in the absence of showing otherwise, the claimed invention is

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either anticipated or found prima facie obvious over the applied prior art. The use of the cationic and anionic dyes is discussed in the rejection above.


Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The JP-A-10-123650 and EP-0866364 A1 cited in Form PTO-1449 filed with the information disclosure statement on October 3, 2000 have been considered and made of record. A correction of Form PTO-1449 was attached herewith.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571)272-1328. The examiner can normally be reached on M-F (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571)272-1526. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea 
July 11, 2004

Thorl Chea
Primary Examiner
Art Unit 1752

